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EXAMINER

LOPEZ, CARLOS N

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/005,567
Filing Date: December 05, 2001
Appellant(s): HYRE ET AL.

MAILED
JUL 23 2007
GROUP 1700

Spencer T. Smith
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/20/07 appealing from the Office
action mailed 11/16/06.

Art Unit: 1731

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A brief on Appeal was filed on December 11, 2006, in a related application serial No. 10/005,682, filed on December 5, 2001.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

The rejection under Rodriguez-Wong in view of Crowder for claims 2-3 is maintained but are not being appealed by Applicant.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5,807,419 Rodriguez-Wong et al 09/1998

Crowder, R. M. "Electric Drives and Their Controls" Oxford Science Publications, 1995, pp.188-191

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez-Wong et al US 5,807,419 ('419) in view of Crowder ("Electric Drives and Their Controls", Richard M. Oxford Science Publications, 1995, Pages 188-191). Rodriguez-Wong discloses a glass-forming machine in order to shape a glass parison in a blowing mold (Abstract). The claimed "a blow head assembly" is '419 element 50. The claimed "support means for supporting said blow head assembly" is deemed as lock 52 of Rodriguez-Wong disclosure.

The "first displacement means for displacing said support means to displace said blow head assembly between a remote up position and an advanced down position" is shown by '419 as piston element 56. The claimed blow tube displaceable between an up and down position is shown by Rodriguez-Wong as element 30. The second displacement means for displacing said blow tube from the up position down to the down position is deemed as '419's cylinder piston assembly 20. Rodriguez-Wong is silent suggesting the displacement means having a profiled actuator. However, in pages 188-189, Crowder teaches "In drive systems, there have been an almost complete shift towards the use of digital rather than analog systems; this results in systems with a number of significant benefits." Among the benefits of using a digital drive is " the use of low-cost microprocessors", "digital

Art Unit: 1731

control provides a highly flexible system", and "due to digital nature of the controller there will be no component variation". In view that digital drives systems are preferred over analog systems such as cylinder piston assembly disclosed by Rodriguez-Wong, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have chosen a digital drive (which includes a servomotor) as the means for displacing the blow tube because it provides a low cost, a highly flexible system, and there is no component variation as taught by Crowder. Additionally, cylinder piston assembly 20 of Rodriguez-Wong is deemed as profiled since the blow tube is only actuated at specific times of the blow molding operation.

Additionally, the "off" and "on" positions are deemed to be when the displacement means is on or off the blow mold wherein the blow tube of Rodriguez-Wong is capable of being moved up and down a plurality of times.

It is noted that the claim 1 recites a plurality of functional features for which do not provide structural distinction to the combined teachings of the above references.

As noted in MPEP 2114:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

Hence, the claimed functional limitation of displacing the blow tube up and down a plurality of times while in the "on" position does not provide a structural distinction from the prior art. The claims are drawn to an apparatus and thus must be structurally distinguished from the prior art.

Additionally, the specification does not explicitly define the "on" position as referring to the blow head assembly engaging the mold.

(10) Response to Argument

Applicant argues that "second displacement means for displacing said blow tube from the up position to the down position and then back up to the up position a plurality of times during the time that the blow head assembly is at the "on" position,"

Applicant further argues that:

"No reference teaches "second displacing means for displacing said blow tube from the up position to the down position and then back up to the up position a plurality of times during the time that the blow head assembly is at the "on" position..."

Art Unit: 1731

The noted arguments are found unpersuasive.

Through out the whole prosecution Applicant has maintained that the references do not disclose the intended use limitation of moving the blow tube up and down a plurality of times while on the "on" position.

As noted in MPEP 2114:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

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Art Unit: 1731

Hence, the claimed functional limitation of displacing the blow tube up and down a plurality of times while in the "on" position does not provide a structural distinction from the prior art. The claims are drawn to an apparatus and thus must be structurally distinguished from the prior art.

The prior art references explicitly establish that there is a second displacing means for the blow tube (see Abstract, Col. 5, lines 45ff, and Claim 1 and 3 of Rodriquez-Wong), yet applicant's argument for patentable distinction orbits on the intended use limitation of displacing the blow tube a plurality of times while on the "on" position.

Thus Applicant's whole basis for patentable distinction is the intended use limitation of having the blow tube move up and down a plurality of times during the "on" position; An improper basis for patentable distinction in view that the claims are apparatus claims whose functional intended use language does not endow a structural feature distinct from that of Rodriquez-Wong.

Moreover, applicant argues against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 1731

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Carlos Lopez/

Conferees:

/Jennifer Michener/

Quality Assurance Specialist

Jennifer Michener

A handwritten signature in black ink, appearing to read "Steven Griffin", with a stylized flourish at the end.

Steven Griffin